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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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08/644,289 05/11/95 RICARDO VARGAS R 899-1350-US

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HM22/1010

EXAMINER

MIRIAM TAN DAVIS

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1642 1642

27

DATE MAILED:

10/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

See attached.

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

MAILED

JUN 27 2002

Ex parte MOLLY F. KULESZ-MARTIN

PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2002-1294  
Application No. 08/644,289

ORDER REMANDING TO THE EXAMINER

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief Administrative Patent Judge, and WILLIAM F. SMITH, Administrative Patent Judge.

*Per Curiam.*

The Office of the Deputy Commissioner for Patent Examination Policy has requested that this application be remanded to the jurisdiction of the patent examiner so that issues raised in this appeal can be reconsidered. Accordingly, we *remand*.

**A. *Findings of Fact.***

An Examiner's Answer was mailed on May 24, 2001 (Paper No. 25). Appellants filed a Reply Brief on June 6, 2001 (Paper No. 26). On October 10, 2001, the examiner responded by entering a Supplemental Examiner's Answer (Paper No. 27).

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief, 37 CFR § 1.193, was amended to read as follows:

[(a)](2) An examiner's answer must not include a new ground of rejection, but if an amendment under § 1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under § 1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under § 1.116 as appellant was so advised. The filing of an amendment under § 1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under § 1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer . . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

- (i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or
- (ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

#### ***B. Conclusion***

In view of the changes to 37 CFR § 1.193, the entry of the Supplemental Examiner's Answer mailed October 10, 2001 (Paper No. 27), is inappropriate.

Apprised of these problems, the Office of the Deputy Commissioner of Patent Examination Policy has requested this remand.

The Board **must** be informed promptly of any action affecting the appeal in this case, including reopening prosecution, allowance and/or abandonment of the application.

**REMAND**

*Bruce H. Stoner*  
BRUCE H. STONER, JR., Chief )  
Administrative Patent Judge )  
*Gary V. Harkcom* ) BOARD OF PATENT  
GARY V. HARKCOM, Vice Chief ) APPEALS AND  
Administrative Patent Judge ) INTERFERENCES  
*William F. Smith* )  
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UNITED STATES DEPARTMENT OF COMMERCE  
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ASSISTANT SECRETARY AND COMMISSIONER OF  
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Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 27

Application Number: 08/644289

Filing Date: 05/10/96

Appellant(s): Molly F. Kulesz-Martin

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Michael L. Dunn  
For Appellant

**EXAMINER'S ANSWER TO REPLY BRIEF**

This is in response to appellant's Reply brief filed on 04/06/01.

**(1) Related Appeals and Interferences**

The Examiner agrees that the brief contains a statement with respect to Related Appeals and Interferences.

**(2) Grouping of claims**

The grouping of claims remains as set forth in the Examiner's Answer.

**(3) Rejection under 35 USC 112, second paragraph**

*Applies new issues & arguments*

*New argument draws to growth regulation is indefinite*

Applicant asserts that the Examiner disregards the claim limitations that the activity referred to is "growth regulation". The Examiner may not broaden the claim language beyond its clear limits and then say that the broadening done by the Examiner is indefinite.

The arguments have been fully considered but are not found convincing for the following reasons:

The referred multitude of functional activity of wild type p53 is DNA binding, DNA repair, transcriptional activation, cellular transformation, cell cycle arrest and apoptosis (see first two lines on page 11 of Examiner's Answer), all of which could be related to growth regulation.

#### **(4) Rejection under 35 USC 112, first paragraph, new matter**

The following new matter issues have been withdrawn: 1) An epitope different from p53 which could be anywhere in p53as, and 2) An epitope unique with respect to all proteins.

The new matter issue of adding or providing or creating an epitope unique to p53as remains. Briefly, although the requirement that p53as differs from p53 at the C-terminal 50 amino acids, the concept of substitution within the last 50 amino acids of wild type p53, and the concept of non-p53 sequences at the terminal end are disclosed in the specification, there is no disclosure of adding or providing or creating an epitope within the C-terminal amino acids which gives rise to antibodies specific to p53as. There is no disclosure of the structure or composition of the claimed added unique epitope.

#### **(5) Rejection under 35 USC 103**

Claims 1, 3, 4 and 17 are rejected under 35 USC(a) as being unpatentable over Han et al, in view of Sambrook et al.

Applicant asserts that the Examiner uses classic hindsight logic by stating that because Han et al teach that a part of p53as (clearly not functional) in a plasmid for the purpose of study renders it obvious to incorporate a complete p53as into a plasmid for use as a vector. This is a clear quantum leap unsupported by the cited art. It is clearly improper by saying that full length sequences for proteins other than p53as have been incorporated into plasmids for study, and somehow that makes it obvious to incorporate a sequence for a different (p53as) into a plasmid, not even for study, but for use as a vector.

Rejection remains for the same reasons set forth in the Examiner's Answer. Briefly, the full length p53as polynucleotide is known in the art and could be obtained from the teaching of Han et al; and further Han et al suggest to study the function of p53 and p53as. Therefore, it would have been obvious to one of ordinary skill in the art to clone full length p53as nucleotide sequence in plasmids for expressing full length p53as protein, because of the following reasons: 1) It is well known in the art that fragments of proteins usually would not have biological activity, as evidenced by Sambrook et al, who also teach that for functional study, large amount of intact native protein is produced, and 2) Expressed full length p53as protein thus could be used for studying the function of p53 and p53as.

For the above reasons, it is believed that the rejections should be sustained as set forth in the Examiner's Answer.

Respectfully submitted,

Minh Tam Davis, PhD.

October 05, 2001



SUSAN UNGAR, PH.D  
PRIMARY EXAMINER